

### **REMARKS**

Claims 17 through 21 and 32 through 51 are pending in the application. Claims 20, 21, 35 and 36 have been withdrawn from consideration. Claims 17, 32, 37, and 49-51 have been amended. Applicant submits that bases for the amendments may be found throughout the application, claims and drawings as originally filed and as such, no new matter has been presented. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **DRAWINGS**

The Office has objected to the drawings as failing to comply with 37 C.F.R. 1.84(p)(4), stating that the reference characters "30" and "70" have both been used to designate the motor. Applicant notes, however, that reference character "30" has been employed to designate a "motor assembly", while reference character "70" has been employed to designate a "motor". In this regard, paragraph [0062] of the present application states that "the motor assembly 30 may include a motor 70, a fan assembly 72, a battery pack 74 and a power switch 76." Accordingly, Applicant respectfully submits that the Office has erred in objecting to the drawings and respectfully requests its reconsideration.

### **REJECTIONS UNDER 35 U.S.C. § 102**

Claims 17, 18, 32-34, 37-39, 42-44 and 49-51 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Japanese patent to Yamamoto (JP 2003-275154). This rejection is respectfully traversed.

Applicant has submitted herewith a declaration under 37 C.F.R. §1.131 showing conception before the publication date of the Yamamoto reference and continuous diligence in the reduction to practice. Accordingly, Applicant submits that the Yamamoto reference is not prior art under 35 U.S.C. 102 and as such, respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 17, 18, 32-34, 37-39, 42-44 and 49-51.

Claims 17, 18, 32-34, 37, 38, 42, 43 and 49-51 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication 2002/0189048 to Maruyama et al. (Maruyama). This rejection is respectfully rendered moot.

Claim 17 includes a hand-held vacuum having a container for the storage of dirt and debris that forms at least a portion of an exterior surface of the hand-held vacuum. The container includes an integral inlet port. Claim 17 also includes a housing having a handle. In contrast, Maruyama appears to disclose vacuum a handle that is associated with a cover (26) rather than the housing and which includes an annular dust collection container (11) that forms no portion of an exterior surface of the vacuum. Moreover, the dust collection container (11) of Maruyama does not include an integral inlet port but rather is open at its top end to receive a flexional portion (35) of a suction tube (32) therein.

Regarding Claims 32 and 37, Applicant notes that Maruyama lacks a dirt cup having an inlet port that extends rearwardly toward a front wall of the housing and a filter that is at least partially disposed between the front wall of the housing and the inlet port.

Regarding Claim 49, Applicant notes that Maruyama lacks a filter that is at least partially disposed between the front wall of the housing and the inlet port and moreover does not direct a dirt and debris laden air flow in a direction toward a housing and a side of an outlet of an inlet port before the dirt and debris laden air flow enters the housing.

Regarding Claim 51, Applicant notes that Maruyama does not direct a dirt and debris laden air flow in a direction about the filter so that the filter is not directly in-line with air exiting the inlet port before the dirt and debris laden air flow enters the housing.

In view of the above-remarks, Applicant respectfully submits that Maruyama does not teach or suggest each and every limitation of Claims 17, 32, 37, 49 and 51. As such, Applicant respectfully requests that the Office reconsider and withdraw the rejection of Claims 17, 32, 37, 49 and 51. Applicant submits that because Claim 18 depends from Claim 17, Claims 33 and 34 depend from Claim 32, Claims 38, 42 and 43 depend from Claim 37 and Claim 50 depends from Claim 49, these claims are in condition for allowance for the reasons set forth, above, regarding Claims 17, 32, 37 and 49, respectively.

Claims 17-19, 32-34, 37, 40-43 and 48-51 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,005,252 to Steiner et al. (Steiner). This rejection is respectfully rendered moot.

Applicant notes that Steiner appears to disclose a hand-held wet-dry vacuum having a deflector (51) that deflects air downwardly away from an air inlet duct (21). From the discussion in column 6, lines 4-21, it appears clear that any swirling of air

takes place between the deflector 51 and the air inlet 21, not around a perimeter of the filter pad 24.

In contrast, Claim 17 includes swirling the dirt and debris laden air flow around a perimeter of the filter within an interior of the container. As noted above, Steiner does not swirl an air flow around a perimeter of a filter.

Claim 32 includes means for swirling the air flow about an interior of the dirt cup in a helical manner between the inlet port and the filter. Steiner does not appear to swirl the air flow in a helical manner between the inlet port and the filter.

Claim 37 includes a flow deflector that causes dirt and debris entrained in the air flow to swirl circumferentially around the interior surface of the dirt cup. Steiner does not appear to swirl an air flow circumferentially or around the interior surface of a dirt cup.

Claim 49 includes directing the dirt and debris laden air flow in a circumferential direction toward the housing and to a side of an outlet of the inlet port before the dirt and debris laden air flow enters the housing. Steiner does not appear to swirl an air flow circumferentially toward the housing and to a side of an outlet of an inlet port.

Claim 51 includes directing the dirt and debris laden air flow in a direction that is generally transverse to the filter before the dirt and debris laden air flow enters the housing so that the filter is not directly in-line with air exiting the inlet port. As noted above, Steiner does not swirl an air flow about a filter.

In view of the above-remarks, Applicant respectfully submits that Steiner does not teach or suggest each and every limitation of Claims 17, 32, 37, 49 and 51. As such, Applicant respectfully requests that the Office reconsider and withdraw the rejection of Claims 17, 32, 37, 49 and 51. Applicant submits that because Claims 18

and 19 depend from Claim 17, Claims 33 and 34 depend from Claim 32, Claims 40- 43 and 48 depend from Claim 37 and Claim 50 depends from Claim 49, these claims are in condition for allowance for the reasons set forth, above, regarding Claims 17, 32, 37 and 49, respectively.

Claims 17-19, 32-34, 37-39, 41-47 and 49-51 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent JP2002-136456 to Ito et al. (Ito). This rejection is respectfully traversed.

Applicant has provided herewith at Tab B a machine-translation copy of the Detailed Description of Ito that is available on the Internet through the Japanese Patent Office web site. Applicant notes that Ito appears to be directed to a hand-held vacuum having a flueway (26) in which an attachment (28) is disposed. The flueway (26) and/or the attachment (28) are apparently configured to reduce losses in suction force. Applicant notes that Ito does not state that air flowing through the flueway (26) is directed into the settling chamber (14) in a manner that causes the air to swirl around the settling chamber (14) and does not describe the air entry (18) as being disposed tangential to the dust filter (20) or the settling chamber (14). Rather, the drawings of the Ito reference simply illustrate the air entry (18) pointed directly at the dust filter (20).

In contrast, Applicant notes that the Ito reference does not teach or suggest: "swirling the dirt and debris laden air flow around a perimeter of the filter within an interior of the container" as recited in Claim 17; "means for swirling the air flow about an interior of the dirt cup in a helical manner between the inlet port and the filter" as recited in Claim 32; "a flow deflector associated with the inlet of the dirt cup, the flow deflector being configured

to direct the air flow toward an interior surface of the dirt cup in a manner that causes dirt and debris entrained in the air flow to swirl circumferentially around the interior surface of the dirt cup” as recited in Claim 37; “directing the dirt and debris laden air flow in a circumferential direction toward the housing and to a side of an outlet of the inlet port before the dirt and debris laden air flow enters the housing” as recited in Claim 49; or “directing the dirt and debris laden air flow in a direction about the filter before the dirt and debris laden air flow enters the housing so that the filter is not directly in-line with air exiting the inlet port” as recited in Claim 51.

Applicant notes that it is well settled that “the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office.” *In re Skinner*, 2 USPQ 2d 1788, 1788-89 (B.P.A.I. 1986). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992).

In *W.L. Gore & Associates v. Garlock, Inc.*, the Federal Circuit stated that “anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). It is not enough, however, that the reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention “*arranged as in the claim*”. *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984).

Anticipation, however, may reside even if the prior art reference relied on does not expressly disclose a minor aspect of the claimed invention. Under the principles of

inherency, if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim of an application, the claim is anticipated. *In re King*, 801 F.2d 1324, 231 USPQ 136, 138 (Fed. Cir. 1986). The Federal Circuit has stated:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991).

In this regard, the CCPA has added that "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (C.C.P.A. 1939) (emphasis in original)).

In view of the above, Applicant respectfully submits that the Examiner has not presented a prima facie case of anticipation. In this regard, the Ito reference does not teach or suggest the limitations of Claims 17, 32, 37, 49 or 51 and moreover, the Examiner cannot rely on inherency to fill in the gaps, as inherency "may not be established by probabilities or possibilities" as noted above. Accordingly, Ito reference is not "a single prior art reference that discloses each element of the claim under consideration". As such, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of Claims 17, 32, 37, 49 and 51 under 35 U.S.C. §102(b).

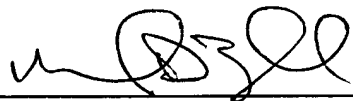
Applicant notes that Claims 18-19 depend from Claim 17, that Claims 33-34 and 43-48 depend from Claim 32, that Claims 38-39 and 41 depend from Claim 37, and that Claim 50 depends from Claim 49 and as such, should be in condition for allowance for the reasons stated above for Claims 17, 32, 37 and 49, respectively.

## CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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By:   
Michael D. Zalobsky  
Reg. No. 45,512

HARNESS, DICKEY & PIERCE, P.L.C.  
P.O. Box 828  
Bloomfield Hills, Michigan 48303  
(248) 641-1600

MDZ/cr